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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/937,052	11/23/2001	Rajinder S. Sidhu	10365/07304	4656

7590 12/29/2003
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EXAMINER

DUFFY, PATRICIA ANN

ART UNIT	PAPER NUMBER
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1645

DATE MAILED: 12/29/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/937,052

Applicant(s)

SIDHU ET AL.

Examiner

Patricia A. Duffy

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-98 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-98 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group 1, claim(s) 1-13, 74 and 75, drawn to a DNA segment encoding a beta-tubulin or a portion thereof, of the fungal species *Pestalotiopsis microspora*. This is the first appearing technical feature.

Group 2, claim(s) 14-27, drawn to an amino acid sequence of at least a portion of a beta-tubulin of the fungal species *Pestalotiopsis microspora*.

Group 3, claim(s) 28-40, 76 and 77, drawn to a DNA segment encoding a beta-tubulin or a portion thereof, of the fungal species *Pythium ultimum*.

Group 4, claim(s) 41-54, drawn to an amino acid sequence of at least a portion of a beta-tubulin of the fungal species *Pythium ultimum*.

Group 5, claim(s) 55-63, 78 and 79, drawn to a DNA segment encoding a beta-tubulin or portion thereof, of the fungal species *Phytophthora cinnamomi*.

Group 6, claim(s) 64-73, drawn to an amino acid sequence of at least a portion of a beta-tubulin of the fungal species *Phytophthora cinnamomi*.

Group 7, claim(s) 80 (in part) 81, 82, and 86 (in part), drawn to method of determining the taxol binding capacity of beta-tubulin using antibodies that bind a taxol binding site of beta-tubulin from a taxol resistant fungal species *Pestalotiopsis microspora*.

Group 8, claim(s) 80 (in part), 83, 84, and 86 (in part), drawn to method of determining the taxol binding capacity of beta-tubulin using antibodies that bind a taxol binding site of beta-tubulin from a taxol resistant fungal species *Pythium ultimum*.

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Group 9, claim(s) 80 (in part), 85, and 86 (in part), drawn to method of determining the taxol binding capacity of beta-tubulin using antibodies that bind a taxol binding site of beta-tubulin from a taxol resistant fungal species *Phytophthora cinnamomi*.

Group 10, claim 87 (in part), drawn to a method of screening a composition for the presence of taxol or taxol-like compounds using the taxol binding portion of beta-tubulin from *Pythium ultimum*.

Group 11, claim 87 (in part), drawn to a method of screening a composition for the presence of taxol or taxol-like compounds using the taxol binding portion of beta-tubulin from *Phytophthora cinnamomi*.

Group 12, claim 88 (in part), drawn to a method of screening a composition for the presence of taxol or taxol-like compounds using mycelia of a taxol sensitive *Pythium ultimum*.

Group 13, claim 88 (in part), drawn to a method of screening a composition for the presence of taxol or taxol-like compounds using mycelia of a taxol sensitive *Phytophthora cinnamomi*.

Group 14, claim 89, drawn to a method of altering the taxol binding property of a recombinantly expressed beta-tubulin by mutation.

Group 15, claims 90 and 92, drawn to a methods of developing taxol-sensitive fungal cells by mutation of position 219 of the amino acid sequence of SEQ ID NO:2

Group 16, claims 91 and 93, drawn to transgenic taxol-sensitive fungal cells.

Group 17, claims 94-96, drawn to a method of screening a composition for the presence of taxol-like compounds using taxol-resistant and taxol-sensitive fungal cells.

Group 18, claim 97, drawn to a method for controlling the growth of plant pathogens using a taxol-producing *Pestalotiopsis microspora*.

The inventions listed as Groups 1-18 do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: The first recited technical feature is drawn to a DNA segment of a beta-tubulin or portion thereof, of the fungal species *Pestalotiopsis microspora*. This feature is not "special" within the meaning of PCT Rule 13.2 because it does not define a contribution over the art because a "portion" of a DNA

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segment is a nucleotide and purified nucleotides were for sale by Sigma Chemical Company in the 1995 catalog, page 46 (see copy included herein) and all combinations of 9-mers were for sale by Stratagene, in the product catalog of 1991 (see copy included herein). Because the first claimed technical feature is anticipated by the art, the feature is not "special" and as such does not define a novel contribution over the art. Therefore, there is no unity of invention between any of the groups of inventions listed *supra*. Further, each of the different nucleic acid sequences and amino acid sequences of Groups 1-6 fail to share a common structural feature and as such do not relate to a single general inventive concept because of the lack of a corresponding technical feature.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patricia A. Duffy whose telephone number is 703-305-7555. The examiner can normally be reached on M-F 10:30pm-7:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Smith Lynette can be reached on 703-308-3909. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.

Patricia A. Duffy
Patricia A. Duffy
Primary Examiner
Au 1645